

Amendments to the Drawings:

The attached new sheet of drawings includes a new Fig. 1A. In Fig. 1A, the flow chart generally describes the manner in which an embodiment of a method of the invention functions.

Attachments: New Figure 1A

### REMARKS

Claims 11-29 and 37-44 are pending in the present application. In the Office Action dated February 24, 2005 the Examiner rejected claims 11, 23, 37 and 41 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification. Claims 11, 23, 37, and 41 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification. Claims 11, 23, 37 and 41 were rejected under 35 U.S.C., first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 12, 38, and 42 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 18 and 27 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification. Claims 11-13, 16-24, 27-29, 37-39 and 41-43 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (U.S. Patent No. 6,067,561) in view of Arnold (U.S. Patent No. 6,275,848). Claims 14, 15, 25, 40 and 44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (U.S. Patent No. 6,067,561) in view of Arnold (U.S. Patent No. 6,275,848) in further view of Foladare et al. (U.S. Patent No. 6,311,210). Claim 26 was rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (U.S. Patent No. 6,067,561) in view of Arnold (U.S. Patent No. 6,275,848) in further view of Landfield et. al. (U.S. Patent No. 5,632,011).

The disclosed embodiments of the invention will now be discussed in comparison to the prior art. Of course, the discussion of the disclosed embodiments, and the discussion of the differences between the disclosed embodiments and the prior art subject matter, do not define the scope or interpretation of any of the claims. Instead, such discussed differences merely help the Examiner appreciate important claim distinctions discussed thereafter.

The present application discloses a method and system for securely distributing an electronic message (*i.e.*, electronic communication) to multiple individual recipients in an

efficient manner using centralized storage and management. In particular, the method involves receiving an electronic message containing an indication of the recipient(s) for the message, and makes a determination whether the indication is for multiple recipients. Unlike conventional methods, the present method uses *an email communication program that makes a conditional decision that if the indication is for multiple recipients*, the program does not send the message to the recipients, but rather centrally stores the message on a server, and sends only a short notification of the message to each of the multiple recipients without sending the message itself. The program does not send the message to any recipient until it receives a response from at least one of the recipients that contains a request for the message. If the indication is not for multiple recipients the message is sent to the recipient without being stored. In various embodiments, the system tracks, tests and routes requests from the recipients to access the message when appropriate and deletes the stored message when all recipients have responded and therefore all have received the message, unless at least one recipient requests that message be saved.

Thus, a single copy of the message can be stored on a server computer for delivery on an individual basis to multiple recipients when requested. In various embodiments, the program (or computer system configured therewith), also stores instructions related to a particular recipient regarding the type of notification to be performed for that particular recipient, and sends the notification according to those instructions of that particular recipient. In certain embodiments, the notification instructions are tailored by a particular recipient and in others, the notification instructions are automatically assigned for a particular recipient. In some cases the notification instructions indicate the message is to be encrypted, and the system performs the encryption accordingly. In certain embodiments, after all recipients have reviewed the message and no recipient has indicated a choice to save the message (or all have indicated a choice to delete the message) the system automatically deletes the single copy of the message. The instructions may include actions to be taken with respect to the message, such as to save or delete the message or to forward the message to another recipient. While a user may ultimately be the source of the instructions, it is the Email communication program that performs the acts based on those instructions. Hence, the program performs these acts transparently to the user.

The centralized storage and management of electronic messages to be distributed to a large number of recipients provides a variety of benefits. Because only a short indicator is sent to each recipient, the recipient's systems require only a small amount of storage space. In addition, each recipient system does not need the necessary software to save and manage the

electronic messages. Instead, the recipient system need only be able to display a message and to send requests and other message action instructions to the server. In addition, central storage of the message provides easy access and control of the original message by an appropriate authorized user who may need access to the centrally message for any number of reasons (e.g., for backup, for authentication, or for modification). Removal or modification of the message to be distributed to a large number of users is therefore easily accomplished.

#### **Objections to the Drawings Under 37 C.F.R. 1.83(a)**

Applicant has added a flow chart (new Figure 1A) that details the acts recited by claims 11, 12, 23, 37, and 38. No new matter has been added because the limitations in the original claims have merely been put in flow chart form. However, Applicant believes that the written description, as a whole, adequately described the conditional limitations objected to by the examiner. Accordingly, the objections to the drawings should be withdrawn.

#### **Claim Rejections Under 35 U.S.C. 112, First and Second Paragraphs**

As discussed above, Applicant has added a flow chart (new Figure 1A) that details the acts recited by claims 11, 12, 23, 37, and 38 along with a new paragraph to the written description describing Figure 1A.

The Examiner stated that the specification does not support “providing an Email communication program on a server that performs the acts of: receiving and indication of an Email communication.” The Examiner stated that “this limitation leaves one to believe that the a server will receive an Email communication, when in fact, it is a user or at least one recipient that will receive and indication of the an Email communication. The Applicant’s specification describes that the recipients receive an indication of the Email communication from the system (i.e. the program on the server), however, the system also receives indications of the email communication to be sent. For example, at page 3, line 25-26 it is stated that the “[T]hat the system first receives an indication of the electronic communication to be sent and receives an indication of the recipient users.” Moreover, item 703 in Figure 7 refers to “present currently stored message indicators to recipients.” Storing the indicators is one form of receiving them. Thus, there is support for the previously presented claim limitation.

The examiner has also rejected claims 11, 37, and 41 due to the limitations “if it is determined that multiple recipients have been indicated: storing a single copy of the Email

communication on the server” purportedly not being found in the specification. The conditional language that is purportedly not found in the specification has been added to the specification. Support for amending the specification is found in the original claims 11 and 37.

With due respect to the Examiner, the statement at the end of paragraph 6 of the Office Action that the Applicant’s specification “...would leave one to believe that a recipient could have a copy of original Email communication stored in a different location exclusive to the recipient” is not on point. This is an option available, in some embodiments. In some embodiments, users can invoke this option subsequent to the Email program storing a single copy of the save message if it is determined that multiple recipients have been indicated.

The examiner has also rejected claims 11, 23, 37, and 41 due to the limitations “if it is determined that multiple recipients have been indicated: notifying .....” purportedly not being found in the specification. Applicant notes that the conditional limitation objected to by the Examiner is not found in independent claim 23. Furthermore, the conditional language that is purportedly not found in the specification has been added to the specification. Support for amending the specification is found in the original claims 11 and 37.

The examiner has also rejected claims 12, 38, and 42 due to the limitations “if it is determined that multiple recipients have not been indicated: sending the Email communication to the recipient without waiting for a request for the Email communication” purportedly not being found in the specification. Again, the Applicant has amended the specification so that there is more clear written description support. Support for amending the specification is found in the original claims 12, 38, and 42.

The examiner has also rejected claims 18 and 27 due to the limitations “retrieving notifying instructions for a recipient by the Email communication program” purportedly not being found in the specification. Again, the Applicant has amended the specification so that there is now more clear written description support. Support for amending the specification is found in the original claims 18 and 27. Furthermore, claims 18 and 27 have been amended to delete the reference to the Email communication program.

Accordingly, the specification now includes a flow chart and corresponding written description directed to the limitations objected to by the Examiner. Therefore, there is a proper written description support for the rejected claims. Furthermore, the claims are enabled because it is within the knowledge of one of ordinary skill in the art to make and use the invention as claimed.

### Cited References

The Examiner has cited the Dillon patent. Dillon is directed to sending notifications (alerts) of Email messages to recipients using a hybrid network that transmits notifications via a continuous high speed channel. Other than these features and in particular, the features regarding how the alerts are sent, the handling of messages as taught by Dillon is conventional in the art. In this regard, Applicant respectfully submits that the Examiner has read more into Dillon than is taught therein and/or has not properly characterized the teaching of that reference, especially in comparison to Applicant's embodiments. In the Office Action the Examiner stated that Dillon teaches:

- If it is determined that multiple recipients have been indicated, (ITEM 1)
  - a. storing the Email communication, (e.g., col. 3, lines 12-65) (ITEM 2)
  - b. notifying each of the multiple recipients of the Email to communication [sic] without sending the Email communication to the recipients (e.g., col. 1, line 25 – col. 2 line 38 and col 3., lines 12-65). (ITEM 3)

Again, Applicant submits that this is not an accurate characterization of what is taught in the cited passages (or anywhere else) in Dillon. Dillon does not teach *anything whatsoever* about storing an Email message **conditionally** based upon anything about the indication, (i.e., **IF** it is determined that multiple recipients have been *indicated*). In this regard, the cited passages of Dillon at most teach storing an email message if the user has not accessed the Email account, not requested the Email, or is not online. This is common in the prior art. Nothing in Dillon, teaches determining *anything* about the *indication* sent to any recipient to make a conditional decision on whether to store the Email message. Therefore the conditional aspect of Item 1 above is not taught in Dillon. Furthermore, the examiner has not pointed to a portion of Dillon that discloses storing an email conditionally.

The deficiency of Dillon is not cured by combination with Arnold. Arnold was cited for teaching “determining whether multiple recipients of the Email communication have been indicated in the received indication. (col 4, lines 25-col. 5, line 25).” Applicant acknowledges that Arnold teaches determining whether multiple recipients of the Email communication have been indicated. However, like Dillon, Arnold does not teach storing the Email message conditionally, based upon whether multiple recipients have been indicated. Indeed, Arnold teaches nothing at all about treating the Email message differently based upon

whether multiple recipients have been indicated. What Arnold teaches at the cited passages and elsewhere, is detaching attachments from Email messages based on size (or other criteria), storing the attachment on the Internet, sending all the designated recipients the Email message devoid of the attachment, but with an embedded URL link, and allowing the recipients access to the stored attachment through the link embedded in the Email message. These features are not conditionally based on whether multiple users have been indicated or not.

Accordingly, the combination of Arnold with Dillon fails to teach or suggest the combination of elements in the various embodiments disclosed by Applicant. Furthermore, Applicant reiterates their argument that there is no motivation to combine the references as combined by the Examiner. Furthermore, neither Foladare nor Landfield cure the deficiencies of Dillon and Arnold.

### **Claims and Rejections**

Turning now to the claims, the patentably distinct differences between the cited references and the claim language will be specifically pointed out. Claim 11 recites, in-part, “if it is determined that multiple recipients have been indicated, storing a single copy of the Email communication on the server; notifying each of the multiple recipients of the Email communication without sending the Email communication to the recipients.” However, the cited references, either individually or in combination, fails to teach or suggest the above conditional limitation. Claims depending from claim 11 are also allowable due to depending from an allowable base claim and further in view of the additional limitations recited in the dependent claims.

Claim 23 recites, in-part, “storing only a single copy of the Email communication on a server, the storing of the only the single copy of the Email communication being automatically performed by the Email communication program because a plurality of recipients have been indicated.” However, the cited references, either individually or in combination, fails to teach or suggest storing only a single copy of the Email communication. Claims depending from claim 23 are also allowable due to depending from an allowable base claim and further in view of the additional limitations recited in the dependent claims.

Claim 37 recites, in-part, “if it is determined that multiple recipients have been indicated, storing a single copy of the Email communication on the server; notifying each of the multiple recipients of the Email communication without sending the Email communication to the

recipients.” However, the cited references, either individually or in combination, fails to teach or suggest the above conditional limitation. Claims depending from claim 37 are also allowable due to depending from an allowable base claim and further in view of the additional limitations recited in the dependent claims.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,  
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MS:clr

Enclosures:

Postcard  
Check  
Fee Transmittal Sheet (+ copy)  
Request for Continued Examination (+ copy)  
8 Sheets of Drawings (Figures 1-7, to include new Figure 1A)

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